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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,521	11/28/2003	Mon-Sheng Lin	BHT-3106-299	7572

7590 04/14/2004

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EXAMINER
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ABDELWAHED, ALI F

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

**Application No.**

10/722,521

**Applicant(s)**

LIN, MON-SHENG

**Examiner**

Ali Abdelwahed

**Art Unit**

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities:

It is suggested that on:

Line 4 of the Abstract, before "...filled up with water..." insert --is--.

Appropriate correction is required.

### ***Claim Objections***

Claim 7 is objected to because of the following informalities:

It is suggested that in:

Claim 7, line 3, delete "expansion" and insert --expansive--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,498,074 to Feldman in view of U.S. Patent No. 5,897,418 to Spector.

Feldman discloses the claimed invention except for the body of the container having a box shape, a cap to seal the water inlet, the expansive toy being affixed to an upright peripheral wall of the container, at least one decorative sticker adhered to an upright peripheral wall of the container, and a plurality of ornaments disposed inside the container. However, Spector teaches a toy comprising a cap (19), the expansive toy being affixed to an upright peripheral wall of the container (see figs. 4, 5, the expansive toy is affixed to the upright peripheral walls of the container through a friction fit between the arms of the expansive toy and the walls of the container), and at least one decorative sticker (20) adhered to an upright peripheral wall of the container (see fig. 5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the toy of Feldman, in view of Spector, such that it would provide the toy of Feldman with a cap, the expansive toy affixed to an upright wall and at least one decorative sticker adhered to an upright wall for the purpose of enhancing the aesthetic value of the toy. In addition, it would have been an obvious matter of design choice to make the different portions of the container of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. Furthermore, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability. *In re Seid* 73 USPQ 431.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feldman in view of Spector as applied to claim 1 above, and further in view of U.S. Patent No. 5,261,848 to Kaplan et al.

Feldman, as modified, discloses the claimed invention except for the expansive toy being affixed to a bottom wall of the container. However, Kaplan et al. teaches a decorative transparent display structure comprising a toy doll affixed to the bottom wall of the container (see figs.1-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the toy of Feldman, as per the teachings of Kaplan et al., such that it would provide the toy of Feldman with the aforementioned limitation for the purpose of restricting the movement of the toy within the container to provide the toy with a stable appearance.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feldman in view of Spector as applied to claim 1 above, and further in view of U.S. Patent No. 5,301,444 to Horiuchi.

Feldman, as modified, discloses the claimed invention except for the expansive toy having a weight at a bottom side thereof. However, Horiuchi teaches a decorative transparent display structure comprising the aforementioned limitation (see figs. 4, 6, 7, [element #23] and column 4, lines 30-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the toy of Feldman, as per the teachings of Horiuchi, such that it would provide the toy of

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Feldman with the aforementioned limitation for the purpose of providing proper balance and buoyancy to the expansive toy.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abdelwahed whose telephone number is (703) 305-3311. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

AA  
04/06/2004

A handwritten signature in black ink, appearing to read 'D. Banks', with a long horizontal line extending to the right.

DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700